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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,108	02/13/2006	Alexandre Avrameas	62745.000020	5477

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
HA, JULIE	

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,108	AVRAMEAS, ALEXANDRE	
	Examiner	Art Unit	
	Julie Ha	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *23 October 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 19-29* is/are pending in the application.

4a) Of the above claim(s) *21-27 and 29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,19 and 28* is/are rejected.

7)☒ Claim(s) *20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Amendment after Non-final rejection filed on October 23, 2007 is acknowledged. Claims 2-18 have been cancelled and claim 29 have been added. Claims 1 and 19-29 are pending in this application. Applicant elected Group II (claims 3 and 8) drawn to an amino acid sequence $(X_1)_pXBBBXBXXBXBBBXBXXB$ and SEQ ID NO:2 in the reply filed on June 18, 2007. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 21-27 remain withdrawn from further consideration and new claim 29 is withdrawn from further consideration, pursuant to 37 CFR 1.142(b), as being drawn to nonelected invention, there being no allowable generic or linking claim. A search was conducted on the elected species of SEQ ID NOS: 1 and 2. A double patenting rejection follows below. Claims 1, 19-20 and 28 are examined on the merits in this office action.

Withdrawn Objections and Rejections

1. Objection to the title is hereby withdrawn due to Applicant's amendment changing the title to "Sequences Facilitating Penetration of a Substance of Interest".

2. Objection to claims 8-12, 19-20 and 28 are hereby withdrawn due to Applicant's amendment to the claims.

3. Objection to claim 20 is hereby withdrawn due to Applicant's amendment to the claim.

4. Objection to claim 1 is hereby withdrawn due to Applicant's amendment to the claim.

5. Rejection under 35 U.S.C. 112, 1st paragraph of claims 1-5, 7, 9-12, 19 and 28 are hereby withdrawn due to Applicant's amendment to the claims.

6. Rejection under 35 U.S.C. 102(e) and 102(a) are hereby withdrawn due to Applicant's amendment to the claims.

New Objection

7. Claim 1 is objected to due to the following minor informalities: At line 3 of the claim, between the 2 sequences, there is a "-". This should be corrected to an "or". Additionally, the correct format for sequence identifier is "SEQ ID NO:" See MPEP 2422 (2)(d).

New Rejection-Obviousness Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

10. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 19 and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-13 of copending Application No. 10/568104 (US PG Pub 2007/0259813 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because if one practiced the claimed invention of the copending application, one would necessarily achieve the claimed invention of instant application and vice versa.

11. Instant claims are drawn to an amino acid sequence being able to facilitate penetration of a substance of interest inside cells and having one of the following sequences: LRRERQSRLRRERQSR (SEQ ID NO: 1), GAYDLRRRERQSRLRRRERQSR (SEQ ID NO: 2). Further, the claims are drawn to a biological, pharmaceutical, cosmetic, agro-food, diagnostic or tracking composition comprising as an active ingredient SEQ ID NO: 1 or SEQ ID NO:2.

12. The copending claims are drawn to a product of the following formula (I): $(A\text{-})_m(X)_p(\text{-}P)_n$ where A is the residue of an anti-bacterial compound, P is the residue of a peptide selected from the group comprising SEQ ID NOS: 1-9 and 11, X represent either a covalent bond between A and P or a spacer arm linking at least an A residue to at least a P residue, m is an integer from 1 to 3, p represents zero or an integer at the most equal to the greater of the numbers m and n, and n is an integer from 1 to 3. SEQ

ID NOS: 6 and 7 have the exactly the same sequence as SEQ ID NOS: 1 and 2 of instant application (see p12, SEQ ID NOS: 6 and 7).

13. The conflicting claims are not identical, but they are not patentably distinct from each other because a product of copending application would necessarily lead to the same product (amino acid sequence and an substance of interest) having amino acid sequences LRRERQSRLRRERQSR or GAYDLRRRERQSRLRRRERQSR complexed with a compound of interest.

14. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1, 19 and 28 are directed to an invention not patentably distinct from claims 12-13 of commonly assigned Application No. 10/568104 (US PG Pub 2007/0259813 A1). Specifically, please see ODP above.

16. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 10/568104 (US PG Pub 2007/0259813 A1), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the

invention in this application was made, or name the prior inventor of the conflicting subject matter.

17. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

18. It should be noted that both Applications (10/568108 and 10/568104) claim priority to EPO 03292030.8 and FRANCE 0309962, yet have different inventors.

19. Please note: This application was examined only on the elected Group II, drawn to an amino acid sequence. Thus, claim 28 was examined only in the context of a biological, pharmaceutical, cosmetic, agro-food, diagnostic or tracking composition, comprising as active ingredient SEQ ID NO: 1 or SEQ ID NO:2.

Conclusion

19. Claim 20 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1, 19 and 28 are rejected.

20. **THIS ACTION IS MADE FINAL because US PG Pub 2007/0259813 A1 was published on November 8, 2007. The Copending application has common assignment as the instant application. The Assignee was aware of the provisional application of the copending application, but did not disclose it prior to the First Office action.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). No claims are allowed.

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Ha whose telephone number is 571-272-5982. The examiner can normally be reached on Mon-Fri, 8:00 am to 4:30 pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Julie Ha
Patent Examiner
AU 1654

12/10/08
ANISH GUPTA
PRIMARY EXAMINER